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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,065	03/06/2001	Donald H. Bouyer	026.00121	4126

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EXAMINER

GRASER, JENNIFER E

ART UNIT

PAPER NUMBER

1645

7

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,065

Applicant(s)

Bouyer et al.

Examiner

Jennifer Graser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, 13-16 and 21, drawn to nucleic acids, vectors, host cells and methods of producing a protein using said nucleic acid, classified in class 536, subclass 23.7.
 - II. Claim 12, drawn to a method of decreasing expression of a R.felis outer membrane protein, classified in class 435, subclass 172.1.
 - III. Claims 17 and 18, drawn to a method of screening a substance for the ability of a substance to modify R.felis outer membrane protein function, classified in class 435, subclass 7.9.
 - IV. Claim 19, drawn to a method of obtaining DNA encoding a R.felis outer membrane protein using oligonucleotide probes, classified in class 536, subclass 24.3.
 - V. Claim 20, drawn to a method of designing degenerate oligonucleotide primers and using them in PCR to identify homologous DNA, classified in class 536, subclass 24.33.
 - VI. Claims 22-24, drawn to DNA oligomers and hybridization methods, classified in class 435, subclass 6.

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VII. Claims 25-28 and 30, drawn to a R.felis outer membrane protein, classified in class 530, subclass 350.

VIII. Claim 29, drawn to an antibody, classified in class 530, subclass 387.1.

IX. Claims 31 and 32, drawn to a method of detecting the presence of R.felis outer membrane protein, classified in class 435, subclass 7.1.

X. Claims 33-42, drawn to methods of preventing or reducing R.felis infections by administering to a carrier host a compound effective to modify or prevent function of a R.felis outer membrane protein, classified in class 424, subclass 234.1.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, VI, VII and VIII are drawn to products which are biologically, chemically, and structurally different and, therefore, represent patentably distinct and independent inventions.

Inventions VIII and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antibody of claim VIII may be used for purposes other than detection, i.e., the antibodies may be used in passive immunization methods.

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

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as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the nucleic acid of Group I may be used in methods other than blocking translation of mRNA, i.e., the nucleic acid may be used in methods to recombinantly produce proteins, amplification methods or detection methods.

Inventions II, III, IV, VI, IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions contain different methods which have different method steps, utilize different reagents and test for different effects or functions. Additionally, the method of Group X uses a compound which is not recited in any of the other groups in order to prevent or reduce function of a *R.felis* outer membrane protein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, and because the literature search for Groups I-X would not be coextensive, restriction for examination purposes as indicated is proper.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1645 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Graser whose telephone number is (703) 308-1742. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

J. Graser 1/27/03
JENNIFER E. GRASER
PRIMARY EXAMINER